

EV 262961729 US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 6794S-000005/US/COA)

In the Application of:)
)
Karali et al.) Confirmation No. 8229
)
Serial No.: 10/031,898)
)
Filed: January 22, 2002)
)
For: Cyclooxygenase-2 Inhibitor)
Compositions Having Rapid Onset)
of Therapeutic Effect)

Commissioner for Patents
Washington, D.C. 20231

Sir:

DECLARATION IN SUPPORT OF
PETITION UNDER 37 C.F.R. 1.47(a)

1. I, STEVEN J. SARUSSI, of 122 South Kaspar Avenue,
Arlington Heights, Illinois 60005, U.S.A., declare as follows:

2. This is a declaration in support of a petition under
37 C.F.R. §1.47(a) and sets forth facts relating to the refusal
of named inventor Subhash Desai, Ph.D. to execute a
Declaration/Power of Attorney for the above-identified patent
application ("the Application").

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3. It is my understanding that the Application was filed in the U.S. Patent and Trademark Office on January 22, 2002, and assigned Serial No. 10/031,898. The Application named, among other individuals, Subhash Desai, Ph.D., as an inventor.

4. Dr. Desai resides at 1011 Greenwood Avenue, Wilmette, Illinois, 60091. He is employed at Baxter Healthcare Corporation, Route 120 & Wilson Road, Round Lake, Illinois, 60073.

5. On August 28, 2002, pursuant to instructions received from Harness, Dickey & Pierce, P.L.C., attorneys of record for the Application, I provided Dr. Desai a copy of the Application together with a Declaration/Power of Attorney for the Application and a letter requesting that Dr. Desai execute the Declaration.

6. I placed telephone calls to Dr. Desai place of employment on September 12, September 23, October 1, October 11, and October 18, 2002 to learn if he had received the August 28, 2002, package or if he had any questions. On about October 28, 2002, Dr. Desai left me a message making essentially the same points discussed in a letter sent to me on November 3, 2002. A copy of that letter is attached hereto as Appendix 1. In his

telephone message, he also said that he believed he was entitled to payment for reviewing other patent applications in the past. In that message he also asked why certain persons were not named as inventors.

7. In a voice message to Dr. Desai on November 6, I provided oral answer to Dr. Desai's questions. I explained that Pharmacia was of the position that it had fairly compensated him in the past and would do so again, but only for reasonable amounts of time. I also pointed out why certain individuals were not listed as inventors on the application.

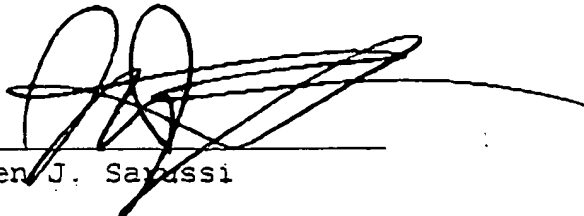
8. On November 20, 2002, I again wrote Dr. Desai by certified mail asking him to execute the Power of Attorney/Declaration. Enclosed with that letter were new copies of all documents previously sent in August of 2002. Dr. Desai has apparently received that November 20, 2002 letter but has not responded in any way to my request to execute the documents.

9. I telephoned Dr. Desai again this morning and left a telephone message on this matter.

10. Dr. Desai continues to refuse to execute the Declaration/Power of Attorney for the Application.

11. I hereby declare further that all statements made herein by my own knowledge are true and that all statements made on information and belief are believed to be true and further that I make these statements with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and of any patent issuing thereon.

December 9, 2002
Date



Steven J. Sarussi



McDonnell Boehnen Hulbert & Berghoff
Law Offices

300 South Wacker Drive 312 913 0001 phone
Chicago, Illinois 60606-6709 312 913 0002 fax
www.mbhb.com

August 28, 2002

VIA FEDERAL EXPRESS

Subhash Desai, Ph.D., MBA
Baxter
Route 120 & Wilson Road
Round Lake, Illinois 60073

Re: U.S. Serial No. 10/031,898
Pharmacia Corporation Case Ref. No. 3267/A/JS
Title: Cyclooxygenase-2 Inhibitors Compositions Having
Rapid Onset of Therapeutic Effect
MBHB Case No. 01-675

Dear Subhash:

Enclosed please find a Declaration/Power of Attorney and an Assignment pertaining to the above-identified patent application. Also enclosed is a copy of the application as filed and Preliminary Amendment. Please briefly review the application and then sign and date the documents where indicated. The deadline for filing these documents apparently falls in the very near future; thus, I ask that you please return these to me as soon as possible.

Please let me know if you have any questions or comments. I look forward to receiving the executed Assignment and Declaration/Power of Attorney documents.

Very truly yours,

Steven J. Sarussi
312 935 2136
sarussi@mbmb.com

SJS/sau
Enclosures

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November 3rd, 2002

VIA FEDERAL EXPRESS

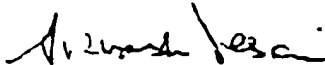
Steven J. Sarussi
McDonnell Boehnen Hulbert & berghoff
300 South Wacker Drive
Chicago, IL 60606-6709

Re: Cyclooxygenase-2 Inhibitors Compositions Having Rapid Onset of Therapeutic Effect- U.S. Serial No. 10/031,898

Dear Steven:

This is in reference to your voice mail inquiring about the status of my review for the above mentioned application. I had left you a reply on your voice mail indicating that this new application and its Preliminary Amendments would require significant review time on my behalf before I can make a decision to sign the Declaration/Power of Attorney and Assignment. I also requested if I was going to be reimbursed for my time to review this application. Since I have not received any communication from you or Pharmacia, I will only resume the review of this application upon resolution of this issue. As you know, I have in the past reviewed applications that you have sent me on the assumption that Pharmacia will reimburse me later. This has not always happened.

Once again, please request Pharmacia to resolve the issues that I have raised. I remain optimistic that the issues can be resolved.



Subhash Desai, Ph.D., MBA
1011 Greenwood Ave
Wilmette, IL 60091

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McDonald Boonin Hulbert & Bergoff
Law Offices

300 South Wacker Drive
Chicago, Illinois 60606-6709
www.mbhb.com

312 913 0001 phone
312 913 0002 fax

November 20, 2002

VIA CERTIFIED MAIL

Subhash Desai, Ph.D., MBA
1011 Greenwood Avenue
Wilmette, Illinois 60091

Re: U.S. Serial No. 10/031,898
Pharmacia Corporation Case Ref. No. 3267/A/US
Title: Cyclooxygenase-2 Inhibitors Compositions Having
Rapid Onset of Therapeutic Effect
MBHB Case No. 01-675

Dear Subhash:

Enclosed please find a Declaration/Power of Attorney and an Assignment pertaining to the above-identified patent application. Also enclosed is a copy of the application as filed and Preliminary Amendment. Please briefly review the application and then sign and date the documents where indicated. The deadline for filing these documents is in early December; thus, please return the executed documents to me by **December 2, 2002**.

Please let me know if you have any questions or comments. I look forward to receiving the executed Assignment and Declaration/Power of Attorney documents.

Very truly yours,

A handwritten signature in black ink, appearing to read "Steven J. Sarussi", is written over a horizontal line.

Steven J. Sarussi
312 935 2136
sarussi@mbmb.com

SJS/sau
Enclosures

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Write Addressee to:

Subhash Desai, Ph.D.
111 Greenwood Avenue
Wilmette, IL 60091

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A. Received by (Please Print Clearly) B. Date of Delivery

C. Signature

X

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☒ Addressee

D. Is delivery address different from item 1? ☐ Yes

If YES, enter delivery address below: ☐ No

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☐ Insured Mail

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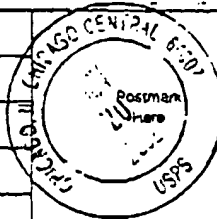
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Sent to Subhash Desai, Ph.D.
Street, Apt. No., or PO Box No. 111 Greenwood Avenue
City, State, ZIP+4 Wilmette, IL 60091

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